

Claim 1 stands rejected under 35 U.S.C. Section 102(e) as being anticipated by the Errico et al. patent. Reconsideration of the rejection under 35 U.S.C. Section 102(e), as anticipated by the Errico et al. patent, as applied to the claims, is respectfully requested. Anticipation has always been held to require absolute identity in structure between the claimed structure and a structure disclosed in a single reference.

In Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81 (Fed. Cir. 1986) it was stated: "For prior art to anticipate under §102 it has to meet every element of the claimed invention."

In Richardson v. Suzuki Motor Co., Ltd., 868 F.2d 1226, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989) it was stated: "Every element of the claimed invention must be literally present, arranged as in the claim."


Specifically, the Office Action states that the Errico et al. patent discloses in Figure 5A an insert having a base portion (136) and a plurality of flexible arms (140). However, when read more specifically, the Errico et al. patent teaches an insert very different from the insert of the present application. The present application claims a cylindrical insert whereas the Errico et al. patent teaches an insert having a tapered portion. Since the Errico et al. patent does not teach a cylindrical insert as claimed in the presently pending independent



claims, the claims are patentable over the Errico et al. patent, and reconsideration of the rejection under 35 U.S.C. Section 102(e) is respectfully requested.


Independent claims 2, 6 and 8 stand rejected under 35 U.S.C. Section 102(e) as being anticipated by the Errico et al. patent. Reconsideration of the rejection under 35 U.S.C. Section 102(e) over the Errico et al. patent, as applied to the claims, is also respectfully requested.

The Office Action states that the Errico et al. patent discloses in Figures 6-9 a body member (201) having rod receiving means (206) and an internal portion (205) with stop means (203) and a radially inwardly extending lip (202) for retaining a screw head (122) and an insert (150). Additionally, the Office Action states that Figures 8 and 9 illustrate the method of spinal rod fixation as claimed. However, while the Errico et al. patent does describe a similar device, the insert for "movably retaining a screw receiving insert therein" is very different. The Errico et al. patent discloses inserting the insert from the top and does not anticipate nor is it possible to place the Errico insert inside the body from the bottom of the body. This is in contradistinction from the present invention. In other words, for the Errico et al. patent to function, the screw must be placed into the insert prior to placing the insert into the body.



Specifically, to push the screw into the insert, the insert must not be inside the body. As is shown by the drawings, to insert the head of the screw inside the insert, the insert must expand outward and open up enough to let the head of the screw slide past the smaller opening of the insert, which explains why the Errico et al. patent does not allow one to place a screw into the insert after placing the insert into the body. This is in contradistinction from the present invention which enables one to place a screw into the insert after placing the insert into the body, as shown on page 18, line 12 of the present application. Given this explicit teaching, there is no teaching of the use of placement of the screw into the insert after the insert is in the body. Since the body member of the present invention as set forth in the claims claiming a body member which allows expansion of the insert during insertion of the screw head into the insert is not disclosed in the Errico et al. patent, the pending claims are patentable over the Errico et al. patent and reconsideration of the rejection is respectfully requested.

The remaining dependent claims not specifically discussed herein are ultimately dependent upon the independent claims. References as applied against these dependent claims do not make up for the deficiencies of those references as discussed above, the prior art references do not disclose the characterizing features of the independent claims discussed above. Hence, it is respectfully submitted that all of the pending claims are patentable over the prior art.



In view of the present amendment and foregoing remarks, reconsideration of the rejections and advancement of the case to issue are respectfully requested.

The Commissioner is authorized to charge any fee or credit any overpayment in connection with this communication to our Deposit Account No. 11-1449.

Respectfully submitted,

KOHN & ASSOCIATES



Kenneth I. Kohn
Registration No. 30,955
30500 Northwestern Highway
Suite 410
Farmington Hills, MI 48334
(248) 539-5050

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on November 16, 1999.



Constance McLean

